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FITCH, EVEN, TABIN & FLANNERY
1801 K STREET, N.W.
SUITE 401L
WASHINGTON, DC 20006-1201

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| EXAMINER |
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MEDLEY, MARGARET B

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1714

DATE MAILED: 10/22/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-22

Office Action Summary

Application No.

09/604,285

Applicant(s)

GATTO ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003 / 05 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,23,25-40,42-52 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,23,25-40,42-52 and 56-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

This office action is in response to Paper No. 18, dated February 14, 2003 and Paper No. 20 dated June 5, 2003.

The amendments to claim 22 and 23, the cancellation of claim 24 and the addition of claims 58-63 in Paper No. 18 dated February 14, 2003 have been entered of record.

The amendments claims 22, 23 and 59-63 in Paper No. 20 dated June 5, 2003 have been entered of record.

The pending claims of record are claims 22-23, 25-40, 42-52 and 56-63.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-39 and 42-52 and newly added claims 58-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 16-19 of U.S. Patent No. 5,650,381. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for improving the antioxidancy and friction properties of a lubricant and a lubricating

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composition comprising a molybdenum compound containing molybdenum and the same diarylamine compounds of the instant claims render obvious the method of for improving antioxidancy and friction properties of a lubricant and a lubricating composition comprising a molybdenum compound containing molybdenum and a diarylamine compound of patentees.

Claims 22-39, 42-52 and 56-57 and newly added claims 58-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 16-19 and 22 of U.S. Patent No. RE 037,363 E. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for improving the antioxidancy and friction properties of a lubricant and a lubricating composition comprising a molybdenum compound containing molybdenum and the same diarylamine compounds, a method for lubricating an engine comprising said lubricating composition and an engine lubricated with said composition of the instant claims render obvious the method of for improving antioxidancy and friction properties of a lubricant and a lubricating composition comprising a molybdenum compound containing molybdenum and a diarylamine compound , a method for lubricating an engine comprising said composition and an engine lubricated with said of patentees.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22-40 and 42-52 and 56-57 and newly added claims 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al 4,648,985 combined with Applicants' Admission in view of Louis de Vries et al 4,394,279.

Applicants claim a method for improving the antioxidant and friction properties of a lubricant comprising adding to the lubricant a molybdenum compound and an oil soluble secondary diarylamine (claim 52); a method for lubricating a crankcase or transmission comprising lubricating a crankcase or transmission with a lubricating composition (claim 56) according to claims 22 or 23; a lubricated engine obtained according to claim 56 (claim 57); and lubricant compositions comprising a lubricating oil, a molybdenum compound, and a secondary diarylamine and further comprising conventional additives in the lubricating oil composition (claims 22-40, , 42-51).

Thorsell et al teach and discloses a there component system lubricant composition comprising a dithiocarbamate, a zinc phosphate compound when zinc is the selected "W" and a molybdenum carboxylate when molybdenum is the selected "Z"

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and when the carboxylate is the selected compound with the further inclusion of conventional additives e.g. an amine oxidant, note column 4 lines 27 to column 5 lines 1-29 and 54 to column 6 lines 1-11 and column 9, lines 30-39. The Thorsell et al further disclose an amine oxidation inhibitor in its lubricant composition, note column 9, lines 33-34.

Patentees further disclose the use of its lubricant composition in enclosed and open gear lubricant system, bearing greases and cam lubricants, note column 11, lines 46 to 51 and column 8, lines 60 to column 9, lines 1-23, which encompass the method for lubricating a crankcase or transmission and lubricated crankcase or transmission of instant claims 56 and 57.

Thorsell et al further disclose process steps for adding to a lubricant oil a molybdenum compound and an amine which is reasonable expected to improve the antioxidancy property and friction property of the lubricating, note column 8, lines 60-65 and column 9, lines 30-34.

Applicants make admission on record at column 1, line 42 to column 3 lines 1 to 38 of the instant application that the prior art teaches well-known molybdenum compounds and aromatic amines that have been used in lubricant compositions. It is noted that the Price 3,285,942, column 1, lines 51-53 and Hunt et al 4,832,857, column 1, lines 60-63 disclosed as prior art by applicants are the same patent containing molybdenum compounds at column 3, lines 60 to column 4, lines 1-45, that are substantially free of phosphorus and active sulfur are used as the molybdenum compounds by applicants in the instant claims.

Applicants further teaches the artisan in the art that :

By "substantially free" they mean that the molybdenum compound contains less than 0.5 % (50000ppm) by weight of the material in question, e.g. active

sulfur which is generally an insufficient amount to add significantly to corrosion. The sulfur content of some commercially available molybdenum compounds can often have as much as about 1,000 ppm of sulfur as a contaminant and occasionally there can be as much as 2,000 ppm of the active sulfur. Such small amounts often come from contamination in processing the various ingredients involved, see column 3, lines 37-46 of the instant application.

The teachings of Thorsell for the three components system, e.g. of Table II of column 9 comprising a dithiocarbamate, with molybdenum octonate (ethylhexanoate) as the metallic octoate component, along with the zinc dithiophosphate being the selected the additional component that is required by the instant claims along with an amine antioxidants rendered the instant claims obvious because the amine of Thorsell is so broad that it would encompass the secondary diarylamine of applicants. The composition of Thorsell comprising 1.0-5.0 % by weight carbamate containing sulfur certainly falls within the guidelines substantially free of sulfur definition made of record by applicants. The zinc dithiophosphate additive lower limits of 1.0 % by weight certainly falls within the guideline of substantially free of phosphorus definition made of record by applicants.

Applicants' make admission on record that the prior art teaches various molybdenum compounds that are commercially available and have been conventionally used in lubricating oil compositions, column 1, line 42 to column 2, lines 1-38. The admitted prior art Price et al US Patent 3,285,942 teach glycol molybdate complexes of instant claim 40. The admitted prior art Hunt et al US 4,832,857 teach overbased molybdenum alkaline earth metal and alkali metal dispersions. Richie et al WO 95/07962 teaches various molybdenum compounds including molybdenum carboxylates, overbased molybdenum-containing complexes, molybdenum compounds

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dithiocarbamates and molybdenum dithiophosphates, molybdenum xanthanates and thioxanthates with secondary amines, see page 8, lines 6-29. The admitted prior art provides the motivation to one of ordinary skill in the art to substitute the admitted prior art well-known molybdenum compounds for the molybdenum compounds of Thorsell and to selected secondary amines as the amine antioxidant of Thorsell with reasonable expectation of improving the antioxidancy and friction properties of lubricating oil compositions.

Applicants' instant claim compositions, methods for improving the antioxidant and friction properties, method for lubricating a crankcase or transmission and lubricated crankcase or transmission are specific to a secondary diarylamine antioxidant and of a specific structure (claims 45-50) and of specific relative proportion of the diarylamine wherein the prior art is silent to said specifics. It is the Examiner's position that the inclusion of an amine of a secondary diarylamine structure in relative proportion of about 750 to 5,000 ppm in the lubricant oil composition would be obvious in view of Louis de Vries et al.

The secondary reference, Louis de Vries et al, discloses 0.05 to 15 % by weight (500-150,000 ppm) sulfur free containing molybdenum complexes in combination with 0.02 to 10 parts by wt. of an aromatic amine in a lubricant (abstract, col. 1 line 53 to col. 2 lines 1-3, and col. 5, lines 1-19) and provides for the preparation of concentrates of the combination of additives within a carrier liquid to provide a convenient method of handling and transporting the additives (col. 8, lines 35-42).

It would have been obvious to the person having ordinary skill in the art at the time of the instant claimed invention to use the secondary amine compounds of Richie and Louis de Vries et al as the amine in Thorsell et al lubricant, concentrate, methods and lubricated engine to arrive at a lubricant having improved antioxidant and friction

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properties and a molybdenum compound which is substantially free of phosphorus and substantially free of active sulfur because combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be a prima facie case of obviousness, See *In re Kerkhoven*, 205 USPQ 1069. The ratios for the molybdenum compound to the diarylamine compound can be determined by routine experimentation as disclosed by Richie, see pages 17-18 and Ex. 7 and Thorsell et al, see column 9, lines 24-26.

It would have been obvious to one of ordinary skill in the art with the teachings of the Admitted prior art of Richie, Price et al and Hunt et al. to select the molybdenum compound that is phosphorus and sulfur free as the molybdenum compounds of Thorsell to arrive at a lubricant having improved antioxidant and friction properties.

Claims 22-40, 42-52 and 56-57 and newly added claims 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art.

Applicants make admission on record at column 2, lines 13-27 that prior art Richie et al (Richie) WO95/07962 teaches crankcase lubricant composition for use with engines comprising copper, molybdenum and aromatic amines.

The instant claims are rendered obvious by Richie teachings directed to a lubricating composition for use in automobile or truck engine, see page 3, lines 17-20 and page 5, lines 24-28, comprising a lubricating oil, a copper additive; not more than 500, and preferably 100, ppm of molybdenum see page 4, lines 11-15 and page 7, lines 32-37, of an oil soluble form e.g. molybdenum carboxylate, see page 8, lines 10-29; and from 0.05 to 2 mass % of at least one oil soluble di(alkylaryl)amine, see page 4, lines 17-21 and page 9, line 26 to page 10, line 14, and further provides for the inclusion of at

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least one or more conventional lubricant additive including zinc dithiophosphate, see page 4, lines 22-32. Richie teaches a lubricating composition comprising a dialkylated amine in combination with molybdenum compound and zinc dithiophosphate see pages 17 and 18, for Table 1, example 7 for 40 ppm of molybdenum from molybdenum 2-ethylhexanoate, 0.3 mass % (3000 ppm) di(nonylphenyl)amine. Thus the instant claims are rendered obvious by the teachings of Richie because there is nothing new about the combination of an oil soluble molybdenum compound with a secondary dialkylated aryl amine and in further combination with conventional lubricant additives.

Applicants are notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

Claims 22-40, 42-52 and 56-57 and newly added claims 59-63 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material, which is not supported by the prior related patents or instant application is as follows:

In claim 22 (and its dependent claims) and claim 56 and claim 57, **wherein the ratio of said oil soluble molybdenum compound relative to said oil soluble secondary diarylamine is about 0.02 to 0.6 parts by weight molybdenum per part of said secondary diarylamine, and said oil soluble secondary diarylamine is present in an amount of at least about 750 to 5,000 ppm of said lubricating composition** is considered as new matter. The newly added limitation to claim 22 is in conflict with the originally filed specification and claims of US Patent RE 037,363 E and US Patent 5,650,381 in that the instant specification at the fourth full paragraph, lines 47-56 of column 6 reads as follows:

Preferably, the quantity of molybdenum in relation to the quantity of the secondary amine should be within a certain ratio. The quantity of molybdenum should be about 0.020 to 0.6 parts by weight for each part by weight of the amine in the lubricating oil composition. Preferably, this ratio will be from about 0.040 to 0.40 parts of the molybdenum per part of the amine and particularly about 0.05 to 0.3 parts of the molybdenum per part of the amine. The total quantity of the molybdenum and amine can be provided by one or more than one molybdenum or amine compound.

The above paragraph is in conflict with applicants alleged support for the newly added limitation to claim 22 (and its dependent claims) and claim 56 and claim 57 for the ratio of molybdenum with the specific amount of about 750 to 5,000 ppm of secondary diarylamine.

In the instant specification under the section titled SUMMARY OF THE INVENTION the third paragraph reads as follows:

In still another aspect, the invention is directed to a lubrication oil concentrate comprising a solvent and a combination of from about 2.5 to 90 percent by weight of an oil soluble molybdenum compound which is substantially free of active sulfur and an oil soluble secondary diarylamine wherein the weight ratio of molybdenum from the molybdenum compound to the diarylamine in the concentrate is from about 0.020 to 0.60 parts molybdenum for each part of amine.

The above paragraph is directed to a concentrate wherein the instant claims are directed to a lubricating composition. Further the above paragraph is in conflict with applicants alleged support for the newly added limitation to claim 22 (and its dependent

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claims) and claim 56 and claim 57 for the ratio of molybdenum with the specific amount of about 750 to 5,000 ppm secondary diarylamine.

In claim 23 (and its dependent claims) and claim 56 and claim 57, **wherein the ratio of said oil soluble molybdenum compound relative to said oil soluble secondary diarylamine is about 0.02 to 0.6 parts by weight molybdenum per part of said secondary diarylamine, and said oil soluble molybdenum compound is present in an amount of at least about 100 to 450 ppm of said lubricating composition** is considered as new matter. The newly added limitation to claim 23 is in conflict with the originally filed specification and claims of US Patent RE 037,363 E and US Patent 5,650,381 in that the instant specification at the fourth full paragraph, lines 47-56 of column 6 reads as follows:

Preferably, the quantity of molybdenum in relation to the quantity of the secondary amine should be within a certain ratio. The quantity of molybdenum should be about 0.020 to 0.6 parts by weight for each part by weight of the amine in the lubricating oil composition. Preferably, this ratio will be from about 0.040 to 0.40 parts of the molybdenum per part of the amine and particularly about 0.05 to 0.3 parts of the molybdenum per part of the amine. The total quantity of the molybdenum and amine can be provided by one or more than one molybdenum or amine compound.

The above paragraph is in conflict with applicants alleged support for the newly added limitation to claim 23 (and its dependent claims) and claim 56 and claim 57 for the ratio of molybdenum with the specific amount of about 750 to 5,000 ppm of secondary diarylamine.

In the instant specification under the section titled SUMMARY OF THE INVENTION the third paragraph reads as follows:

In still another aspect, the invention is directed to a lubrication oil concentrate comprising a solvent and a combination of from about 2.5 to 90 percent by weight of an oil soluble molybdenum compound which is substantially free of active sulfur and an oil soluble secondary diarylamine wherein the weight ratio of molybdenum from the molybdenum compound to the diarylamine in the concentrate is from about 0.020 to 0.60 parts molybdenum for each part of amine.

The above paragraph is directed to a concentrate wherein the instant claims are directed to a lubricating composition. Further the above paragraph is in conflict with applicants alleged support for the newly added limitation to claim 23 (and its dependent claims) and claim 56 and claim 57 for the ratio of molybdenum with the specific amount of about 100 to 450 ppm molybdenum compound.

Claims 59-63 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material, which is not supported by the prior related patents or instant application is as follows:

In claim 59 the "at least about 104 ppm molybdenum" phrase is broader than the specified "104 ppm molybdenum" found in Table 5 of the instant specification.

In claim 60 the "at least about 156 ppm molybdenum" phrase is broader than the specified "156 ppm molybdenum" found in Table 5 of the instant specification.

In claim 61 the "less than about 468 ppm molybdenum" phrase is broader than the specified "468 ppm molybdenum" found in Table 5 of the instant specification.

In claims 22 and 23 the phrase "wherein said lubricating composition is free of supplemental antioxidant selected from the group consisting of sulfurized phenols, sulfurized olefins, dialkyl dithiocarbamates, and phenothiazines" appears to be in

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conflict with the disclosure at lines 36-51 of column 7 of the instant specification as set forth below:

"(d) Antioxidants. In molybdenum-free oils other antioxidants in addition to the zinc dihydrocarbyl dithiophosphates are used to protect the oil from oxidative degradation. The amount of supplemental antioxidant will vary depending on the oxidative stability of the base stock. Typical treat levels in finished oils can vary from about 1.0 to 2.5 wt. %. The supplementary antioxidants that are generally used include hindered phenols, hindered bisphenols, sulfurized phenols, alkylated diphenylamines, sulfurized olefins, alkyl sulfides and disulfides, dialkyl dithiocarbamates, and phenothiazines. The inclusion of molybdenum carboxylates with diphenylamines removes the need for these supplementary antioxidants. However, a supplementary antioxidant may be included in oils that are less oxidatively stable or in oils that are subjected to unusually severe conditions."

The said passage appears to support only the combination for molybdenum carboxylates with diphenylamines. The claims as drafted are broader in scope than the portion of the specification that applicants have relied to support newly added claims 62-63.

The passage at lines 12-20 of column 3 of the instant specification is set forth below:

"A key advantage of this invention is the multifunctional nature of the molybdenum/diarylamine combination and the relatively low treat levels required for a performance benefit. This additive combination provides both oxidation control and friction control to the oil. This reduces the need for supplemental oxidation protection and frictional properties and should

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reduce the overall cost for the entire additive package. Further cost reduction is gained by the low treat levels employed."

The said passage does not appear to support the instant drafted claims 62-63. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-23, 25-40, 42-52 and 56-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation to claims 22 and 23 (and their dependent claims) that the "said oil soluble molybdenum compound is present in an amount to be effective as an antioxidant" in the last two lines of claim 22 and "said oil soluble molybdenum compound is present in an amount of about 100 to 450 parts per million of said lubricating composition" in the last two lines of claim 23 appears to be new matter. In claim 23 the amount is based on the molybdeunm of the compound and is not based on the molybdenum compound. In claim 22 the molybdenum compound along with the diarylamine provides the antioxidant and friction properties to the lubricant.

Claims 22 (and its dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The molybdenum compound is present to provide molybdenum in an amount along with the diarylamine to be effective as an antioxidant and a frictional modifier are critical or essential to the practice

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of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure found in the second full paragraph under the Summary of the Invention at column 3 of the instant specification demonstrates that said features were considered essential by the applicants, are not reflect in the claims that are rejected.

Applicant's arguments filed February 14, 2003 and June 5, 2003 have been fully considered but they are not persuasive.

Applicants argue that their description of their invention cannot constitute a prior art **"admission"**.

The examiner agrees with applicants' argument. The prior art made of record at column 1, lines 49 to column 2, lines 1-39 of the instant specification by applicants is admitted prior art. It is also further noted that applicants have also incorporated the prior art admission of Price et al 3,285,942 and Hunt et al 4,832,857 at column 3, line 60 to column 4, lines 1-46 of the instant application as part of their instant claimed invention. But since applicants have made admission on record that the Price 3,285,942 and Hunt et al 4,832,857 are prior art, the examiner will maintain the position on record that the said references are considered as admitted prior art teaching references.

Applicants' own admissions are prior art. *Constant V. Advance Micro Devices Inc.* 7 USPQ 2d 1057 (Fed Cir. 1988) ; *Tyler Refrigeration v. Kysor Industrial Corp.* 227 USPQ 485 (Fed Cir. 1985) ; *In re Nomiya* 184 USPQ 607 (CCPA 1975).

Thus applicants' argument is deemed moot.

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Applicants argue that the newly limitation added to claims 22 and 23 that the molybdenum compound being present in an amount to be effective as an antioxidant finds support from the instant specification, particularly at Table 5. This appears to be only part of the teaching set forth in Table 5, as well as the teaching set forth in the second full paragraph under the Summary of the Invention in column of the instant specification that clearly teaches the antioxidancy and friction properties of a lubricant by the incorporation of a molybdenum compound and a secondary diarylamine compound.

At page 6 of Paper No. 18 applicants alleges the 0.5% by weight of about 100 ppm to about 450 ppm of molybdenum compound cannot provide 50,000 ppm active sulfur is not grounds to rebut applicants admission that "substantially free" of sulfur means "molybdenum compound contains less than 0.5% (5,000 ppm) by weight material in question, e. g. active sulfur which is generally an insufficient amount to add significantly to corrosion". Further the newly added limitation in claim 23 "the amount of oil soluble molybdenum compound is about 100 ppm to about 450 ppm" is considered as new matter.

Applicants are reminded that the White reference U.S. Patent No. 4,330,420 has not been relied on in the art rejection of record and therefore the arguments of record will not be addressed in this response.

The examiner agrees with applicants' arguments that the admitted prior art WO 95/07963 to Richie not only teaches molybdenum carboxylate, note page 8, lines 10-29, but also teaches sulfur-containing compounds. Thus Richie teachings directed to the

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molybdenum carboxylate clearly is a teachings that rendered obvious the instant claims of record. Applicants are reminded that a reference is considered and relied upon in its entirety. The instant claims as drafted with the open-ended language "comprising" does not exclude the copper compound of Richie. Further Richie is not limited to the alleged preferred only 5 to 50 ppm of the molybdenum compound as argued by applicants at the paragraph bridging pages 11-12 of Paper No. 18. It is further noted that claims 22 and 23 as drafted reads on as low as 15 to 100 ppm and 450 to 3,000 ppm of molybdenum when there is 0.02 to 0.6 parts of molybdenum per parts of about 750 to about 5,000 ppm of arylamines.. Therefore, the teachings of Richie rebuts applicants' arguments made of record.

The examiner maintains the position stated of record in the art rejection that the 103 rejection over Thorsell combined with Applicants Admission in view of Louis de Vries is proper for reason made of record on pages 4-8 of Paper no. 16 dated October 16, 2002. The sections of each references that have been relied upon have been carefully set forth in Paper No.16 and are not repeated herein. Applicants are further reminded that a reference is considered and relied upon in its entirety.

Applicants' own admissions are prior art. Constant V. Advance Micro Devices Inc. 7 USPQ 2d 1057 (Fed Cir. 1988) ; Tyler Refrigeration v. Kysor Industrial Corp. 227 USPQ 485 (Fed Cir. 1985) ; In re Nomiya 184 USPQ 607 (CCPA 1975).

Applicants clearly states in columns 1 and 2 under the section entitled Description of the Related Art that U.S. Patents 4,34,279 by L. de Vries , 3,285,942 by

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Price and 4,832,857 by Hunt and WO/95/07962 by Richie are prior art. The said references are as best admitted prior art by admission by applicants.

Thus applicants alleged improper combination of the Thorsell an alleged admission and the De Vries is rebutted by the rebuttal set forth supra.

The examiner acknowledges applicants' intention to file the proper terminal disclaimers.

The references cited and made of record in the letter Patent 5,650,381 and RE 37,363 E and by the examiner have been reviewed and reconsidered.

The prior art cited but not applied further teach lubricant oil compositions comprising additives of the same nature as claimed by Applicants.

The listing of references on Paper No. 21 dated June 16, 2003 is not a proper information disclosure statement. Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. In this case the said references were not considered by the examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

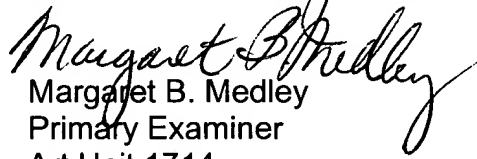
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

Margaret B. Medley
October 21, 2003